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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,395	02/22/2005	Gunter Kaupp	KAUPPI	7134
1444 7590 04/11/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
ABU ALI, SHUANGYI				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
04/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,395

**Applicant(s)**

KAUPP ET AL.

**Examiner**

SHUANGYI ABU ALI

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 11, 13-20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 11, 13-20 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/17/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/17/2008 has been entered.

*In general, applicants argue the purity of the pigments (aluminum, copper, bronze, gold, silver) used in the instant application. The examiner respectfully submits that with respect to the presence of the impurity such as mercury, arsenic, lead and so on, it is considered that because the instant claims recites the language "less than" in defining the amount of those components, the fact that Andes et al. or the cited prior art do not disclose the presence of those component is seen to read upon the range instantly claimed, since the phrase "less than" is considered to include the value of zero (0). In re Mochel, 176 U. S. P. Q. 194 (CCPA 1972). Furthermore, it is well known in the art to use pigment free of heavy metals (impurities) in cosmetic and other applications. (Please see pigment for high performance)*

*It is noted that claims 1, 11, 13, and 15 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a*

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*product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 77F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985) (citations omitted).*

*The recitation of cosmetic preparation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).*

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 10 and 16-20 are rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5, 607, 504 to Schmid et al. alone or in view of the article entitled "Pigment for high performance".

The references differ from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Regarding claims 1-2, 10, 17-18, Schmid et al. disclose a pigment composition comprising a substrate selected from any metal and alloys in plate-like form, such as aluminum, copper, brass, bronze et al ( col. 3, lines 55-59), a coating of silica ( col. 2, lines 43-45) and a coating of Iron oxide. The silica coating's thickness is in the range of 10-800 nm, prefer in the range of 50-600 nm (col. 3, line 47). The diameter of the substrate is not critical per se and can be adapted to the particle use. Normally the particles have an average largest diameter in the range of 5-100  $\mu\text{m}$  and a thickness of 0.5  $\mu\text{m}$  (col. 4, lines 20-25). The claim recites the intended use of a pigment. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, and then it meets the claim.

Regarding claim 16, Schmid et al. disclose that the weight ratio of the silica coating to the substrate is in the range of 1-0.0001 (col. 8, line 11).

Regarding claim 19, Schmid et al. disclose that wet chemical process is used to provide the coatings for the pigment.

Regarding claim 20, Schmid et al. disclose that the pigments can be used in cosmetic application (col. 1, lines 16-19).

With respect to the impurities, it is the examiners position that since the references fail to mention any impurities, thus constitutes a teaching that they are either not present or present in such a small amount, thus reading on the claimed invention. In the alternative, it is well known in the art to use pigment free of heavy metals (impurities) in cosmetic and other applications, thus the use of a pigment without impurities is well within the scope of the skilled artisan.

Claims 1-2, 10, 13-14, 17-18 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/09617 alone or in view of the article entitled "Pigment for high performance".

This rejection is over the WO 00/09617 because the reference qualifies as prior art under 35 U.S. U. 102 (b). However, for convenience, the paragraph and line numbers of the English language equivalent US Patent Application Publication No 2003/0209169 cited below.

The references differ from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Regarding claims 1-2, 10, 13-14 and 17-18, Andes et al. disclose a pigment composition comprising of a metallic substrate such as aluminum, silver, zinc, or alloy et al. and a coating layer of silica ([0022]. The coating layer thickness is in the range of 30-600 nm. The metallic substrate thickness is in the range of 0.2-4.5  $\mu\text{m}$  and the other two dimension is between 5-50  $\mu\text{m}$  ([0018]). The claim recites the intended use of a pigment. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, and then it meets the claim.

Regarding claim 25, Andes et al. disclose that wet chemical process is used to provide the coatings for the pigment ([0027]).

Regarding claim 26, Andes et al. disclose that the pigments can be used in cosmetic application ([0002]).

With respect to the impurities, it is the examiners position that since the references fail to mention any impurities, thus constitutes a teaching that they are either not present or present in such a small amount, thus reading on the claimed invention. In the alternative, it is well known in the art to use pigment free of heavy metals

(impurities) in cosmetic and other applications, thus the use of a pigment without impurities is well within the scope of the skilled artisan.

Claims 11, 15, 23-24 and 27-28 are rejected under 35 U.S.C. 103(a) as obvious over U. S. Patent No. 5, 607, 504 to Schmid et al., in view of U. S. Patent No. 3389105 to Bolger et al. alone or in view of the article entitled "Pigment for high performance".

Regarding claims 11 and 15, Schmid et al. disclose metal flake used as substrate in a pigment composition as applicants set forth in claim 1, but they are silent about the substrate are bronze or gold as applicant set forth in claims 13 and 15.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use gold or bronze flakes in Schmid et al. pigments as applicant set forth in claims 11 and 15, motivated by the fact that Bolger et al., also drawn to pigment used in ink or paint et al. applications, disclose that metal flake are widely used in metallic pigment (col. 1, lines 30-35).

Regarding claims 23 and 27, Schmid et al. disclose that wet chemical process is used to provide the coatings for the pigment.

Regarding claim 24 and 28, Schmid et al. disclose that the pigments can be used in cosmetic application (col. 1, lines 16-19).

With respect to the impurities, it is the examiners position that since the references fail to mention any impurities, thus constitutes a teaching that they are either not present or present in such a small amount, thus reading on the claimed invention. In the alternative, it is well known in the art to use pigment free of heavy metals



(impurities) in cosmetic and other applications, thus the use of a pigment without impurities is well within the scope of the skilled artisan.

### ***Response to Arguments***

Applicant's arguments with respect to Reisser et al. Souma, Nadkarni, Saha, Chide and Bolger from the previous office action dated July 10, 2007 have been considered but are moot in view of the new ground(s) of rejection.

*In general, applicants argue the purity of the pigments (aluminum, copper, bronze, gold, silver) used in the instant application. The examiner respectfully submits that with respect to the presence of the impurity such as mercury, arsenic, lead and so on, it is considered that because the instant claims recites the language "less than" in defining the amount of those components, the fact that Andes et al. or the cited prior art do not disclose the presence of those component is seen to read upon the range instantly claimed, since the phrase "less than" is considered to include the value of zero (0). In re Moche, 176 U. S. P. Q. 194 (CCPA 1972). Furthermore, it is well known in the art to use pigment free of heavy pigment in cosmetic and other application. (Please see pigment for high performance).*

Applicants argue that the amended independent claims recite the thickness of the pigment coating layer. The Examiner respectfully submits that newly cited reference disclose the thickness of the pigment coating layer.

Regarding claims 1, 11, 13 and 15, the examiner position is that those claims are product by process (i.e. specifically recite how the layer is produced) and even though

product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 77F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985) (citations omitted).

Applicants argue that Bolger disclose of pigment with organic coating. The examiner respectfully submits that Bolger is used to show the gold and Bronze are wildly used in metallic pigment.

The examiner acknowledges the safety data sheets submitted by applicants on 1/10/08, however, the examiner is unclear as to how these are relevant to the above rejections and/or show unobviousness of the pending claims over the art defined above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

SA